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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,333	07/27/2001	Yoshiharu Takahashi	212067US2	7095

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ALEXANDRIA, VA 22314

EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/915,333

Applicant(s)

TAKAHASHI, YOSHIHARU

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date April 14, 2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on April 14, 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

The drawings filed on August 27, 2001 are acceptable.

Specification

The abstract of the disclosure is objected to because there are reference numbers designating the various features of the invention. Correction is required by removing the reference numbers. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite,

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failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "the procedure" lacks an antecedent basis.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrases "the product image" and "the plurality of product images" lack antecedent basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, ~~5/1~~, ~~5/3~~ and ~~6-7~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,633,849 to Dodd in view of U.S. Patent No. 6,609,106 to Robertson.

Regarding claims 1 and 3, Dodd discloses a method comprising the steps of:

- performing arrangement for sending the gift, the procedure of the arrangement including that the sender accesses a homepage of a gift center via Internet,

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- selects a gift, and specifies an E-mail address or a terminal address capable of receiving and sending an E-mail of the receiver (see at least col.3, lines 40-52);
- performing arrangement for sending the gift, the procedure of the arrangement including that the sender accesses a homepage of a gift center via Internet, selects a gift, downloads a product image of the gift and transmit an E-mail attached with the product image to the receiver via Internet (see at least col.3, lines 40-52; Figure 2A; col. 5, lines 56-63; col. 6, lines 25-27; Figure 2E); and
 - distributing of an E-mail to the receiver by the gift center via Internet, for promoting the receiver to access the homepage of the gift center to the look through the product image of the fit from the sender (see at least col. 3, lines 52-55; col. 5, lines 22-26; col. 5, lines 56-63; Figure 2E);
 - performing arrangement for receiving the gift, the procedure of the arrangement being such that when the receiver receives the gift from the sender, the receiver specifies the receiving method of the gift center (see at least col. 6, lines 29-33).

However, Dodd does not disclose the sender registers as a member. Dodd discloses a gift giver is a computer user who connects online to a gift server node in a computer network (col. 3, lines 40-42). Robertson, on the other hand, Robertson teaches the sender registers as a member (see at least col. 9, lines 52-63; col. 11, lines 55-57).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Dodd, to include the sender registers as a member, as taught by Robertson, so as to provide sender information

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such as name, address, payment information, etc. to present a streamlined process for purchasing gifts over a distributed public network (Robertson see abstract).

Regarding claims 5/1 and 5/3, Robertson discloses the member registration is performed by inputting ID instead of the member registration (see at least col. 6, lines 24-25).

Regarding claims 6-7, Dodd discloses a system comprising:

- a server of a gift center, the server comprising a homepage, a gift product information file, and a product image file (see at least col.3, lines 40-52; Figure 2A; col. 5, lines 56-63; col. 6, lines 25-27; Figure 2E);
- a client of the sender, the sender accessing the homepage from the client to select a gift and specifying an E-mail address or a terminal address capable of receiving an E-mail, and the server transmitting the E-mail to the receiver (see at least col.3, lines 40-52);
- a client, the sender accessing the homepage from the client to select a gift, downloading the product image from the server and transmitting an E-mail attached with the product image to the receiver (see at least col. 3, lines 52-55; col. 5, lines 22-26; col. 5, lines 56-63; Figure 2E); and
- a client of the receiver, the receiver reading the E-mail from the client of the receiver and accessing the homepage to look through the product image of the gift from the sender, and the receiver specifying the receiving method to the server from the client of the receiver when the receiver receiving the gift (see at least col. 6, lines 29-33).

However, Dodd does not disclose the sender registers as a member. Dodd discloses a member database (col. 3, lines 40-42). Robertson, on the other hand, Robertson teaches a member database (see at least col. 9, lines 52-63; col. 11, lines 55-57).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Dodd, to include the member database, as taught by Robertson, so as to provide sender information such as name, address, payment information, etc. to present a streamlined process for purchasing gifts over a distributed public network (Robertson see abstract).

Claims 2, 4, 5/2, and 5/4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,633,849 to Dodd in view of U.S. Patent No. 6,609,106 to Robertson, and in further view of U.S. Patent No. 6,453,300 to Simpson. Dodd discloses a method comprising:

- performing arrangement for sending the gift, the procedure of the arrangement including that the sender accesses a homepage of a gift center via Internet, and specifies an E-mail address or a terminal address capable of receiving and sending an E-mail of the receiver (see at least col.3, lines 40-52);
- performing arrangement for sending the gift, the procedure of the arrangement including that the sender accesses a homepage of a gift center via Internet, selects a gift, downloads a product image of the gift and transmit an E-mail attached with the product image to the receiver via Internet (see at least col.3, lines 40-52; Figure 2A; col. 5, lines 56-63; col. 6, lines 25-27; Figure 2E); and

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- distributing of an E-mail to the receiver by the gift center via Internet, for promoting the receiver to access the homepage of the gift center to the look through the product image (see at least col. 3, lines 52-55; col. 5, lines 22-26; col. 5, lines 56-63; Figure 2E);
- performing arrangement for receiving the gift, the procedure of the arrangement being such that when the receiver receives the gift from the sender, the receiver specifies the receiving method of the gift center (see at least col. 6, lines 29-33).

However, Dodd does not disclose the sender registers as a member. Dodd discloses a gift giver is a computer user who connects online to a gift server node in a computer network (col. 3, lines 40-42). Robertson, on the other hand, Robertson teaches the sender registers as a member (see at least col. 9, lines 52-63; col. 11, lines 55-57).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Dodd, to include the sender registers as a member, as taught by Robertson, so as to provide sender information such as name, address, payment information, etc. to present a streamlined process for purchasing gifts over a distributed public network (Robertson see abstract).

Furthermore, the combination of Robertson and Dodd substantially discloses the claimed invention, however, the combination does not disclose a plurality of candidate of the gift and the receiver selecting one of the plurality of gifts. The combination discloses the gift giver selects a product from the recipient from a variety of products supplied from one or more vendor (Dodd col. 3, lines 46-48). Simpson, on the other

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hand, teaches the a plurality of candidate of the gift and the receiver selecting one of the plurality of gifts (see at least col. 1, lines 64-67; col. 7, lines 11-21; claim 19).

Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Dodd and Robertson, to include a plurality of candidate of the gift and the receiver selecting one of the plurality of gifts, as taught by Simpson, so as to provide a variety of gifts to the receiver, thus providing a gift that the receiver would enjoy.

Regarding claims 5/2 and 5/4, Robertson discloses the member registration is performed by inputting ID instead of the member registration (see at least col. 6, lines 24-25).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,774, 874 to Veeneman et al. discloses a multi-merchant gift registry system.

U.S. Patent No. 6,050,493 to Fertig discloses a gift card which has drawings of a plurality of pre-selected gift items.

U.S. Patent No. 6,493,742 to Holland et al. discloses a system for providing internet accessible registries.

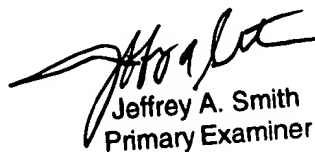
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
June 1, 2004



Jeffrey A. Smith
Primary Examiner